

### **Remarks**

Applicant thanks Examiner Canella for the courtesies extended to Applicant's representative during the telephonic interview conducted on January 23, 2009. Applicant submitted a paper with the substance of that interview on February 23, 2009.

Claims 1, 2, 4-9, 11, 12 and 14-16 are currently pending in the application. In order to advance prosecution, Applicants have amended claims 12 and 15, and added claims 17-19. The amendments to the pending claims are made in order to expedite the issuance of the claims. The amendments are made without prejudice, do not constitute amendments to overcome any prior art rejection, and do not present any new matter. Support for the newly added claims can be found throughout the specification as filed.

### **Priority**

The Office Action accorded an effective priority date of January 12, 2001, the filing date of the present application, to claims 12 and 14-16. Although not acquiescing to this priority date determination for these claims, or the Examiner's reasoning supporting this priority date determination, Applicants have amended claims 12 and 15 to recite the use of SA  $\beta$ -Gal and p21 as biological markers. Correspondingly, Applicant respectfully contends that the priority date of claims 12 and 14-16 is January 12, 2000, the filing date of U.S. Provisional Applications Nos. 60/176,514 and 60/176,515, and respectfully requests that the Office accord the present claims with such a priority date.

### **Discussion of the 35 U.S.C. § 102 Rejection**

Claims 12 and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Roninson *et al.* (U.S. 2004/0058320) (“Roninson application”).

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found in a single art reference. *Verdegall Bros. v. Union Oil Co.*, 814 F.2d 628, 631 2 U.S.P.Q.2d (BNA) 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. The identical invention must be shown in complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131.

As discussed above, claims 12 and 14, as amended, are entitled to a priority of January 12, 2000. The Roninson application was filed on December 21, 2001, and its earliest claimed priority date was to provisional application No. 60/257,907, filed on December 21, 2000. As such, the Roninson application is not prior art to claims 12 and 14. In view of the inapplicability of the Roninson application as prior art, Applicant respectfully requests withdrawal of this § 102 obviousness rejection and requests reconsideration of the claims.

Furthermore, Applicant notes that newly added claims 17-19 are not subject to this anticipation rejection. However, in order to expedite prosecution of this application, Applicant respectfully points out that these newly added claims are directed to the use of SA  $\beta$ -Gal activity, p27 expression and/or p16 expression as biological markers. The Office Action’s citation of the Roninson application does not mention or allege that the Roninson application teaches or discloses any of SA  $\beta$ -Gal activity, p27 expression and/or p16 expression as biological markers. As such, the Roninson application does not teach each and every limitation of claims 17-19, and could not anticipate these claims regardless of its effective priority date.

### **Discussion of the 35 U.S.C. § 103(a) Rejections**

Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Roninson application in view of Bacus (U.S. 4,741,043). Applicant respectfully traverses this rejection.

As discussed above, claims 15 and 16, as amended, are entitled to a priority of January 12, 2000. As explained above, the Roninson application was filed on December 21, 2001, and its earliest claimed priority date was to provisional application No. 60/257,907, filed on December 21, 2000. As such, the Roninson application is not prior art to claims 15 and 16. Moreover, the present Office Action has not alleged that Bacus anticipates claims 12 and 15, and therefore the Office Action has not taken the position that Bacus teaches each and every element of the claims. In view of the inapplicability of the Roninson application as prior art, and of the failure of Bacus to teach each and every element of the claims, Applicant respectfully requests withdrawal of this § 103 obviousness rejection and requests reconsideration of the claims.

In addition, Applicant notes that newly added claims 17-19 are not subject to this obviousness rejection. However, in order to expedite prosecution of this application, Applicant respectfully points out that these newly added claims are directed to the use of SA  $\beta$ -Gal activity, p27 expression and/or p16 expression as biological markers. The Office Action's citation of the Roninson application does not mention or allege that the Roninson application teaches or discloses any of SA  $\beta$ -Gal activity, p27 expression and/or p16 expression as biological markers. Further, the Office Action only cites to Bacus as teaching the determination of optical density by image analysis, and does not allege that Bacus teaches or discloses the use of SA  $\beta$ -Gal activity, p27 expression and/or p16 expression as biological markers. Without the citation of any reference that discloses the use of SA  $\beta$ -Gal activity, p27 expression and/or p16 expression as

biological markers, Applicant respectfully contends that newly added claims 17-19 are not subject to the present obviousness rejection.

### **Conclusion**

In view of the above amendments and remarks, the application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issue. If there are any questions or comments regarding this Response or application, the Examiner is encouraged to contact the undersigned attorney as indicated below.

Respectfully Submitted,

Date: May 27, 2009

/Andrew W. Williams/

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